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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,409	03/17/2004	Reid Von Borstel	12382-4	5555

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EXAMINER

MAYES, DIONNE WALLS

ART UNIT PAPER NUMBER

1731

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,409

Applicant(s)

VON BORSTEL, REID

Examiner

Dionne Walls Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-12,14,18 and 21-25 is/are rejected.
- 7) ☒ Claim(s) 3-7,13,15-17,19,20 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Reopened Prosecution – Vacation of Notice of Allowance

1. Prosecution on the merits of this application is **reopened** on claims 1-2, 8-12, 14, 18, and 21-25, which are considered unpatentable for the reasons indicated below.
2. Applicant is advised that **the Notice of Allowance mailed on 06/09/2005 is vacated**. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-2, 8-12, 14, 18, and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al (US. Pat. No. 5,009,239) in view of Lesser et al (US. Pat. No. 5,839,447).

Cohen teaches a cigarette having a tobacco smoke filter comprising polyethyleneimine (which corresponds to the claimed "one or more than one polycationic polymer", and also the limitation of claims 8 and 12 which actually recites

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the specific chemical. Additionally, it automatically meets the molecular weight limitations of claims 9-10), added in the amounts recited in claims 24-25 (see col. 3, lines 1-6). Cohen et al differs from the claims in that it does not also teach the inclusion of metal phthalocyanine to the tobacco filter. However, Lesser et al teaches the advantages of using copper phthalocyanine in tobacco smoke filters to remove toxic and mutagenic compounds from tobacco smoke (see col. 5, lines 32-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the filter of Cohen et al to include the copper phthalocyanine, taught in Lesser et al, so that toxic and mutagenic compounds can also be filtered from the tobacco smoke generated by smoking the cigarette having the filter of Cohen et al attached.

Regarding claim 11, Cohen et al does not require that its filter comprises any cellulose acetate, as this substance is merely one of many (i.e. polypropylene / polyethylene) that can be used to fabricate the disclosed filter. (see col. 3, lines 41-51, col. 6, lines 17-25)

Regarding claim 14, Cohen et al discloses the use of acids to modify the pH of the filter (col. 2, lines 68)

Regarding claim 18, it follows that the additives would be dispersed uniformly throughout the filter in order to fully receive the benefits of the substances in filtering out harmful tobacco smoke components.

Regarding claims 21-23, the invention suggested by the combined references would automatically meet these claim limitations.

Allowable Subject Matter

5. Claims 3-7, 13, 15-17, 19-20 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne Walls Mayes
Primary Examiner
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